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EXAMINER

CARTER, MONICA SMITH

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/085,688

Applicant(s)

MIJDAM ET AL.

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 5 and 7, it is not clear what is meant by "displaced from said die cut labels."

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kornell et al. (5,161,687).

Kornell et al. disclose a reclosable label package (10) comprising a plurality of die cut labels (20) formed in a label substrate (16) adhesively secured (via adhesive 18) to a carrier (12); and a protective cover (26) disposed over the die cut labels and secured in place by an adhesive (24) disposed about the periphery of the protective cover and the label substrate which when the protective cover is removed, leaves no tacky residue on the cover or the label substrate (see col. 3, lines 47-62- "...the cover

layer adhesive 24 is placed only on the lateral portions 22 of the label layer 16, and not on any of the labels 20.”).

Regarding claims 2-4, Kornell et al. disclose the cover layer adhesive (24) being “any of a wide variety of releasable and resealable known to those of ordinary skill in the art.” (see col. 3, lines 59-62). Inherently, this would include a dry peel adhesive that is a cationic adhesive. It is noted that the process of curing the adhesive by exposure to ultraviolet radiation does not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113)

Regarding claim 5, Kornell et al. disclose the dry peel adhesive being disposed about the periphery of the package and not in contact with the die cut labels (see col. 3, lines 47-62- “...the cover layer adhesive 24 is placed only on the lateral portions 22 of the label layer 16, and not on any of the labels 20.”).

Regarding claim 6, Kornell et al. disclose the dry peel adhesive being disposed between the protective cover and the label substrate (as seen in figure 2). It is noted that the process of curing the adhesive by exposure to ultraviolet radiation after the protective cover is secured does not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113)

Regarding claim 7, Kornell et al. disclose the dry peel adhesive being disposed at various positions on the package and is displaced from the die cut labels (see col. 3, lines 47-62- "...the cover layer adhesive 24 is placed only on the lateral portions 22 of the label layer 16, and not on any of the labels 20.").

Regarding claim 8, Kornell et al. disclose the dry peel adhesive being disposed between the protective cover and the label substrate (as seen in figure 2). It is noted that the process of curing the adhesive by exposure to ultraviolet radiation after the protective cover is secured does not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113)

Regarding claim 9, Kornell et al. disclose a carrier (12) having a front surface; a release coating (14) applied to the front surface of the carrier (see col. 3, lines 13-14); a label substrate (16) having first and second surfaces, a pressure sensitive adhesive (18) (see col. 3, lines 37-40 – "The adhesive type will preferably be permanent...cold temperature.") securing the label substrate to the front surface of the carrier (see col. 3, lines 40-42); a plurality of die cut labels (20) in the label substrate; dry peel adhesive (24- Kornell et al. disclose the cover layer adhesive (24) being "any of a wide variety of releasable and resealable known to those of ordinary skill in the art." (see col. 3, lines 59-62). Inherently, this would include a dry peel adhesive.) disposed upon the second surface but not on the die cut labels (see col. 3, lines 47-62); and a light permeable protective cover (26 – formed from a clear, transparent stock material) secured to the

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dry peel adhesive. ). It is noted that the process of curing the adhesive by exposure to ultraviolet radiation after the protective cover is secured does not structurally limit the claim. The patentability of a product does not depend on its method of production.

Product-by-Process claims are not limited to the manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113) Further, removing when the protective cover is removed there is no tacky adhesive residue remaining on the label substrate or the protective layer since the adhesive is releasable and resealable as set forth above.

Regarding claims 10 and 11, Kornell et al. disclose the cover layer adhesive (24) being "any of a wide variety of releasable and resealable known to those of ordinary skill in the art." (see col. 3, lines 59-62). Inherently, this would include a dry peel adhesive that is a cationic adhesive. It is noted that the process of curing the adhesive by exposure to ultraviolet radiation does not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113)

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kornell et al. in view of Ko et al. (5,308,887).

Kornell et al. disclose a method of making a shielded label package comprising the steps of providing a label substrate (16) secured to a surface of a carrier (12) with a pressure sensitive adhesive (18); printing a plurality of labels (20) on the label substrate (see col. 3, lines 32-34); die cutting the plurality of labels (see col. 3, lines 32-34); applying dry peel adhesive upon the label substrate but not in contact with the labels (see col. 3, lines 47-62); and securing a light permeable protective cover (26- clear, transparent stock material) to the dry peel adhesive.

Kornell et al. disclose the claimed invention except for explicitly disclosing curing the dry peel adhesive.

Ko et al. disclose pressure-sensitive adhesives that are radiation curable. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kornell's invention to include radiation curable adhesives, as taught by Ko et al., to provide a secure attachment between the protective cover and the label substrate.

Regarding claim 13, Kornell et al., as modified by Ko et al., inherently disclose passing ultra violet radiation through the light permeable protective cover, since the adhesive is located beneath the protective cover.

Regarding claim 14, it is inherent to the invention of Kornell et al., as modified by Ko et al., that the step of sheeting would occur following the curing step to provide the final product of the shield label package for display for sale and use by the consumer.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-



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0305. The examiner can normally be reached on Monday-Thursday (7:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

January 14, 2004

  
**MONICA S. CARTER**  
**PRIMARY EXAMINER**